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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/153,838 09/15/98 WILS

P ST96016-US

EXAMINER

005487  
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HM22/0817

KETTER, J

ART UNIT

PAPER NUMBER

1636

6

DATE MAILED:

08/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/157,838

Applicant(s)

Wils et al.

Examiner

J. KETTER

Group Art Unit

1636

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 6/1/99
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 1-22 is/are allowed.
- ☒ Claim(s) 23-26 <sup>second</sup> is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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Claims 1-22 are allowed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 23-26 stand rejected under 35 U.S.C. 102(e) as being anticipated by Woodard et al. (A) or Horn et al. (B), for reasons of record set forth in paper No.2, mailed 23 November 1998.

In the amendment filed 1 June 1999, Applicants argue that neither reference teaches separation of plasmid and chromosomal DNA. However, such a step is taught in Horn et al., column 1, lines 14-54, where it is clear that the invention is intended for purification of plasmid DNA; and in Woodard et al., at column 1, lines 12-33, where it is also clear that the invention is intended for purification of plasmids.

Applicants further argue that neither the chromosomal content nor the endotoxin content, as recited in the claims, is taught for the DNAs of either reference. However, in view of the highly purified nature of said DNAs, as taught by both Horn et al. and Woodard et al., such low contamination levels would have been inherent.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Certain papers related to this application may be submitted to Art Unit 1805 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993)(see 37 CFR § 1.6(d)). The Art Unit 1805 Fax number is (703) 308-0294. **NOTE:** If Applicant *does* submit a paper by fax to this number, the examiner must be notified promptly, to ensure matching of the faxed paper to the application file, and the original signed copy should be retained by Applicant or Applicant's representative. (703) 308-4242 or (703) 305-3014 may be used without notification of the examiner, with such faxed papers being handled in the manner of mailed responses. Applicants are encouraged to use the latter two fax numbers unless immediate action by the

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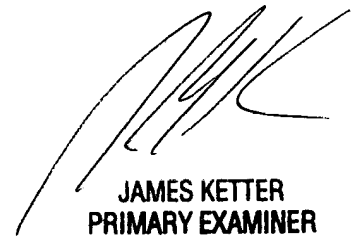
examiner is required, e.g., during discussions of claim language for allowable subject matter. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Ketter whose telephone number is (703) 308-1169. The Examiner can normally be reached on Monday-Thursday from 8:00 AM-5:30 PM, and on alternate Fridays.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, George Elliott, can be contacted at (703) 308-4003.

James Ketter

August 11, 1999



JAMES KETTER  
PRIMARY EXAMINER